

Application No. 10/537,098
Reply to November 3, 2008 Office Action

Docket No.: 2409-0155PUS1

REMARKS

Claims 1-10 are pending. Claims 1, 2 and 10 are independent. By this Amendment, claim 2 has been amended by re-writing it in independent form. No new matter is involved.

Reconsideration of this Application, as amended, is respectfully requested in light of the following remarks.

Indication of Allowable Subject matter

The Office Action indicates that claims 2, 3 and 5 contain allowable subject matter, and that claim 2 would be allowed if re-written in independent form. Claim 2 has been re-written in independent form and, because of this, claims 2, 3 and 5 are in condition for allowance.

Rejection under 35 USC §103

Claims 1, 4 and 6-10 stand rejected under 35 USC §103(a) as being unpatentable over U.S. patent 4,878,427 to Washchynsky et al. ("Washchynsky") in view of U.S. Patent 6,318,257 to Niemiro et al. ("Niemiro"). This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention

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was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *See Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed

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invention, all the claim limitations must be suggested or taught by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *See C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Plasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Claim 1 recites a printing module provided with a frame, an impression roller, a plate cylinder assembly comprising a plate cylinder which is provided with a print image and which, in use, with interposition of a substrate to be printed, abuts against the impression roller, an

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anilox roller and a doctor roller, the doctor roller taking up ink from an ink reservoir, the anilox roller being arranged between the doctor roller and the plate cylinder, such that a desired amount of ink is taken off the doctor roller by the anilox roller and transferred to the plate cylinder, the plate cylinder assembly being provided with a stationary shaft on which the plate cylinder is rotatably bearing-mounted, while on opposite sides of the plate cylinder a support is fixedly connected with the stationary shaft, the printing module comprising two receiving units disposed on opposite sides of the plate cylinder, which are connected with the frame, in which receiving units rest the supports when the plate cylinder assembly in the operative position is mounted in the printing module, while fixation means are provided for fixating the plate cylinder assembly in the receiving units, wherein the fixation means are situated substantially under the plate cylinder assembly.

Claim 10 recites a printing machine provided with at least one printing module provided with a frame, an impression roller, a plate cylinder assembly comprising a plate cylinder which is provided with a print image and which, in use, with interposition of a substrate to be printed, abuts against the impression roller, an anilox roller and a doctor roller, the doctor roller taking up ink from an ink reservoir, the anilox roller being arranged between the doctor roller and the plate cylinder, such that a desired amount of ink is taken off the doctor roller by the anilox roller and transferred to the plate cylinder, the plate cylinder assembly being provided with a stationary shaft on which the plate cylinder is rotatably bearing-mounted, while on opposite sides of the plate cylinder a support is fixedly connected with the stationary shaft, the printing module comprising two receiving units disposed on opposite sides of the plate cylinder, which are connected with the frame, in which receiving units rest the supports when the plate cylinder

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assembly in the operative position is mounted in the printing module, while fixation means are provided for fixating the plate cylinder assembly in the receiving units, wherein the fixation means are situated substantially under the plate cylinder assembly.

The Office Action indicates that Washchynsky discloses the claimed invention except for fixing means for fixing the plate cylinder to the receiving units, where the fixing means are located substantially under the plate assembly.

In an attempt to remedy this deficiency, the Office Action turns to Niemiro which is said to contain two fixation means 84, 86, which are not "fixation means for fixating the plate cylinder assembly in the receiving units," as recited. Applicants respectfully submit that elements 84 and 86 in Niemiro are nothing more than the bearings located between the plate cylinder 29 and the stationary, non-rotating, plate cylinder support shaft 72. Bearings 84 and 86 of Niemiro are part of the plate cylinder assembly, and do not fixate the plate cylinder assembly in receiving units.

Niemiro does not even have plural receiving units, but only has a single receiving unit (side wall) 14 for supporting plate cylinder assemblies 22, 24, 26 and 28 (two of which are shown in detail in Fig. 2, for example), and bearings 84, 86 clearly have nothing to do with fixing Niemiro's plate cylinder assemblies to its single supporting plate.

In fact, modifying Niemiro in view of this interpretation of Niemiro would result in an inoperative device because Niemiro's bearings 84, 86 could not possibly fixate Washchynsky plate bearing assemblies, as recited.

Applicants also respectfully submit that Niemiro's plate cylinder assemblies 22, 24, 26 and 28 are actually fixed to side wall 14 using mounting bolts 76, thrust washer 78 and thrust

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bearings 80, all of which are substantially located to the side of the plate cylinder assemblies 22, 24, 26 and 28 rather than substantially under the plate cylinder assemblies, as claimed.

Even if one of ordinary skill in the art were properly motivated to reconstruct Washchynsky's device to include Nicmiro's mounting bolts 76, thrust washer 78 and thrust bearings 80, they would not disclose, suggest, or otherwise render obvious the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 1, 4 and 6-10.

Reconsideration and withdrawal of this rejection of claims 1, 4 and 6-10 are respectfully requested.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.136 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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